UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: September 28, 2006

Opposition No. 91164233

Dole Fresh Fruit Company

v.

Economy Cash And Carry, L.P.

Before Hohein, Walters and Walsh,
Administrative Trademark Judges.

By the Board:

Dole Fresh Fruit Company has filed an opposition against Economy Cash and Carry, L.P.'s application Serial No. 78351762 for the mark TROPICAL GOLD for "nonalcoholic beverages, namely, noncarbonated flavored drinks and fruit juices."[1]

As grounds for opposition, opposer asserts priority of use and alleges that applicant's mark, as used in connection with the identified goods, so resembles opposer's marks as to be likely to cause consumer confusion, to cause mistake, or to deceive. Specifically, opposer alleges that (1) it is the owner of U.S. Registration Nos. 1265895 and 2757489,

[1] Application Serial No. 78351762, filed January 14, 2004, under an intent-to-use basis pursuant to Section 1(b) of the Trademark Act.

both for the mark TROPICAL GOLD, for "fresh papaya and pineapple delivered to retail customers in airports" and "fresh fruits", respectively;[2] that (2) from a long time prior to the filing date of the opposed application, or any earlier date of actual use of the mark shown in the opposed application upon which applicant can rely, opposer and its predecessors-in-interest have used the trademark TROPICAL GOLD in connection with fresh fruit; and that (3) opposer will be damaged by the registration of the mark shown in the opposed application because registration will give applicant prima facie evidence of the validity of its confusingly similar mark and the exclusive nationwide right to use its confusingly similar mark in commerce in connection with the goods identified in the opposed application, in derogation of opposer's rights in its registered marks.

Applicant has filed an answer denying the salient allegations of opposer's notice of opposition.

This case now comes up for consideration of opposer's motion for summary judgment on its likelihood of confusion claim under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d). The motion has been fully briefed. The Board has

[2] U.S. Registration No. 1265895, registered January 31, 1985 (Section 8 and 9 Affidavits were accepted and granted on February 23, 2004) and U.S. Registration No. 2757489, registered August 26, 2003.

considered opposer's reply brief in its determination. *See* Trademark Rule 2.127(a).

In support of its motion, opposer argues there are no genuine issues of material fact with respect to priority and likelihood of confusion. Opposer maintains that there is no issue of priority because opposer relies upon its ownership of a subsisting registration of the mark TROPICAL GOLD.[3] Further, opposer contends that its standing to oppose is established by its ownership of said registration. Moreover, opposer argues that the involved marks are identical in appearance, sound, meaning and commercial impression, and that the involved goods are closely related and are sold in the same channels of trade and to the identical class of purchasers.

As evidence in support of its motion, opposer has submitted the declaration of Marcy Reed, an intellectual property paralegal in the legal department of opposer's parent company, Dole Food Company, Inc., which introduces the following exhibits: (i) a true and correct copy of the certificate of registration for U.S. Registration No. 2757489 for the mark TROPICAL GOLD for "fresh fruits," issued by the U.S. Patent and Trademark Office ("USPTO") and showing that the registration is subsisting and owned by

[3] The Board notes that opposer solely relies on its U.S. Registration No. 2757489 for the mark TROPICAL GOLD for "fresh fruits" for purposes of its motion for summary judgment.

opposer; (ii) copies of fifty-six active third-party registrations retrieved from the Trademark Application and Registration Retrieval (TARR) database which identify both fresh fruit and fruit juices and/or other juice-based beverages in the identification of goods for each registration; (iii) copies of pages from the commercial company websites of Chiquita, Ocean Spray, POM Wonderful, Sunkist, Tropicana, Welch's and Mott's displaying the sale of both fresh fruit and fruit juices under each of the aforementioned house marks respectively; (iv) copies of registrations owned by Chiquita Brands, Inc., Ocean Spray Cranberries, Inc., POM Wonderful, LLC, Sunkist Growers, Inc., Tropicana Products, Inc., and Welch Foods Inc. retrieved from the TARR database, which identify both fresh fruit and fruit juices and/or other juice-based beverages in the identification of goods; and (v) copies of pages from applicant's website located at www.cashandcarry.com which demonstrate use of applicant's own "RED & WHITE" label brand in connection with canned and dried fruits and canned and bottled juices.

In opposition to the motion, applicant argues that, although applicant's and opposer's goods may on first impression appear to be somewhat related, they are in fact quite different in light of the prior contemporaneous use of the mark TROPICAL GOLD on both soft drinks and fruit juices

and fresh fruit in the marketplace by different owners without confusion over an eight year period. In particular, applicant contends that a third-party, namely, Wolmex Beverage Company, was issued a federal trademark registration for the mark TROPICAL GOLD for "nonalcoholic beverages, namely, noncarbonated soft drinks and fruit juices" despite the existence of opposer's previously registered TROPICAL GOLD mark for "fresh pineapple and papaya delivered directly to retail customers in airports." Applicant further states that these two registered marks co-existed for eight years without any evidence of actual confusion and without any action by opposer to cancel Wolmex Beverage Company's TROPICAL GOLD registration. Applicant further argues that opposer's TROPICAL GOLD mark for "fresh fruits" was granted a federal trademark registration even though the TROPICAL GOLD registration, originally owned by Wolmex Beverage Company and subsequently assigned to Magnolia Coca-Cola Bottling Co., was valid and subsisting at the time opposer's mark registered. In light of the foregoing, applicant argues that, as a matter of law, opposer cannot now claim that a likelihood of confusion exists between opposer's TROPICAL GOLD mark for "fresh fruit" and applicant's TROPICAL GOLD mark for "nonalcoholic beverages, namely, noncarbonated flavored drinks and fruit juices."

Finally, applicant asserts the existence of thirteen current third-party registrations for fruit juices for marks incorporating the term TROPICAL that do not have companion registrations for fresh fruit. Applicant argues that the co-existence of such registrations in the marketplace further demonstrates a lack of likelihood of confusion between the parties' marks because the public has long been exposed to numerous marks held by numerous different owners for fruit juices and fruit-flavored drinks with the word "TROPICAL" in the mark.

In support of its arguments, applicant has submitted the declaration of Mike Dipp, chairman of the Board of Economy Cash and Carry G.P and general partner of applicant, which introduces the following exhibits: (i) copies of opposer's registration nos. 1265895 and 2757489 retrieved from the Trademark Application and Registration Retrieval (TARR) database; (ii) copies of pages downloaded from the USPTO website showing the prosecution history of applicant's application serial no. 78351762 for the mark TROPICAL GOLD for "non-alcoholic beverages, namely, non-carbonated flavored drinks and fruit juices" also retrieved from the TARR database; (iii) a copy of Wolmex Beverage Company's registration no. 2096590 for the mark TROPICAL GOLD retrieved from the TARR database; (iv) copies of the assignment of registration no. 2096590 for the mark TROPICAL

GOLD from Wolmex Beverage Company to Magnolia Coca-Cola Bottling Company retrieved from the USPTO's assignment branch website; and (v) copies of thirteen active registrations retrieved from the Trademark Electronic Search System (TESS) database which include the term "TROPICAL" as the first term in the mark and identify "fruit juices" in the identification of goods, but not fresh fruit.

In reply, opposer contends that the thirteen third-party registrations submitted by applicant in support of its opposition to opposer's motion are inadmissible as irrelevant. Specifically, opposer argues that applicant has failed to demonstrate actual use of the subject marks and, therefore, the submission of the third-party registrations alone has little to no probative value. Similarly, opposer claims that applicant has provided no evidence that Wolmex Beverage Company's TROPICAL GOLD mark was ever used, much less that it was used to such an extent as to make the absence of any actual confusion sufficient to defeat summary judgment. In view thereof, opposer contends that applicant has failed to raise a genuine issue of material fact that would deny opposer's motion for summary judgment.

Summary judgment is appropriate when the record shows that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A dispute as to a material fact

issue is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant and must draw all reasonable inferences from underlying facts in favor of the nonmovant. Id.

The party seeking summary judgment bears the initial burden of informing the Board of the basis for its motion and identifying those portions of the record which it believes demonstrates the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts which must be resolved at trial. The nonmoving party may not rest on mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record, or produce additional affidavit evidence, showing the existence of a genuine issue of material fact for trial. If the nonmoving party does not so respond, summary judgment, if appropriate,

shall be entered in the moving party's favor. See Fed. R. Civ. P. 56(e).

In this case, we believe that opposer has carried its burden of showing *prima facie* the absence of any genuine issue of material fact, and its entitlement to judgment as a matter of law. Furthermore, the Board finds that the evidence applicant has submitted in opposition to opposer's motion for summary judgment does not raise a genuine issue of material fact with regard to either priority or likelihood of confusion. Additionally, we do not find the arguments set forth in applicant's opposition papers persuasive.

First, there is no genuine issue of material fact as to priority because the certified copy of opposer's pleaded U.S. Registration No. 2757489 for the mark TROPICAL GOLD for "fresh fruits" establishes that the registration is subsisting and owned by opposer. Priority, therefore, is not in issue. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We find that opposer also has carried the burden of establishing that no genuine issues of material fact remain and that it is entitled to judgment as a matter of law on the issue of likelihood of confusion. In reaching our decision, we have carefully considered the relevant factors enumerated in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d

1357, 177 USPQ 563 (CCPA 1973). *See Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

First, there is no genuine issue of material fact as to the similarities between the marks at issue. Indeed, applicant concedes that the appearance, sound, connotation and commercial impression of applicant's and opposer's respective marks are identical. *See* p. 5 of Applicant's Response To Opposer's Motion For Summary Judgment.

Second, applicant also concedes that the trade channels of applicant's goods and opposer's goods are presumed to be the same and that potential purchasers of the parties' goods are likely to purchase the respective goods under similar conditions. *Id.*

Third, there is substantial evidence in the record which demonstrates that third-parties market and sell both fresh fruits and fruit juices and/or other juice-based beverages under the same trademark. In light of such evidence, the Board concludes that purchasers would likely assume that producers of fresh fruits would also manufacture fruit juices and/or other juice-based beverages and, therefore, would believe that the both types of goods emanate from the same source, especially if the goods are marketed under the same mark. Indeed, the Federal Circuit has held that when goods are shown to be made by the same

manufacturer, such a showing has a definite bearing on the likelihood that the public will think, when they do appear under the same mark, that they have the same source. *See Sterling Drug v. Sebring*, 515 F.2d 1128, 185 USPQ 649 (CCPA 1975). In view thereof, no genuine issue of material fact remains with respect to the relatedness of the parties' respective goods.

Finally, although applicant points to the lack of any evidence of actual confusion, we note that the absence of actual confusion is not sufficient to raise a genuine issue. Indeed, opposer is not required to prove actual confusion in order to make a prima facie showing of likelihood of confusion. *See Block Drug. Co. v. Den-Mat, Inc.*, 17 USPQ2d 1315 (TTAB 1989); *Airco, Inc. v. Air Equipment Rental Co., Inc.*, 210 USPQ 492 (TTAB 1980).

Because there are no genuinely disputed factual issues which require trial for their resolution, and because the undisputed facts of record establish, as a matter of law, that opposer is entitled to judgment on its Section 2(d) claim, opposer's motion for summary judgment is granted.[4] *See* Fed. R. Civ. P. 56(c).

[4] The Board notes that the instant order granting opposer's motion for summary judgment is based only on opposer's ownership of U.S. Registration No. 2757489 for the mark TROPICAL GOLD for "fresh fruits."

Judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.